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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,675	08/24/2001	Toshiyuki Tamura	IDE.006	3440

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EXAMINER

SING, SIMON P

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/935,675	TAMURA, TOSHIYUKI	
	Examiner	Art Unit	
	Simon Sing	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 20-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siemens N4-000476 in view of Sato et al. US2003/0032440.

1.1 Regarding claim 20, Siemens discloses a method for achieving transcoder free operation in figures 5 and 6. Siemens teaches inserting a transcoder (TrFO Break Function) in a network node (MGW) when a mobile station moves from RNC-A to RNC-A', receiving RFCI map from RNC-A (step 4, figure 6) and sending the RFCI map to RNC-A' (step 11, figure 6). The RNC-A' changes to the RFCI map as requested and new TrFO operation is achieved (step 14 and thereafter, figure 6). Siemens fails to specifically teach how the RFC-A' obtains the RFCI of the mobile station to achieve the TrFO operation (transcoder removed).

However, Sato discloses that an encoding rate (RFCI) of a mobile station is controlled by a Radio Network Controller (RNC) (paragraphs 3-6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Siemens' reference with the teaching of Sato so that RNC-A' would have sent a command to change the encoding rate of a mobile station for accomplishing a TrFO, because such a modification would have clarified how RNC-A' successfully obtained a requested RFCI from a mobile station to achieve a TrFO.

1.2 Regarding claim 21, Siemens teaches a MSC in figure 6.

1.3 Regarding claim 22, Siemens teaches a MGW in figure 6.

1.4 Regarding claim 23, the modified Siemens reference teaches AMR (see para. 2 and 3 of Sato).

1.5 Regarding claim 24, Siemens teaches RFCI as stated above.

1.6 Regarding claim 25, Siemens teaches a transcoder free operation (TrFO) at the end of figure 6.

1.7 Regarding claims 26 and 38, Siemens discloses a system for achieving transcoder free operation in figures 5 and 6, comprising a switching node MGW (switching means) and two radio network controllers RNC-A and RNC-A' (radio network

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controlling means). Siemens teaches inserting a transcoder (TrFO Break Function) in a network node (MGW) when a mobile station moves from RNC-A to RNC-A', receiving RFCI map from RNC-A (step 4, figure 6) and sending the RFCI map to RNC-A' (step 11, figure 6). The RNC-A' changes to the RFCI map as requested and new TrFO operation is achieved (step 14 and thereafter, figure 6). Siemens fails to specifically teach how the RFC-A' obtains the RFCI of the mobile station to achieve the TrFO operation (transcoder removed).

However, Sato discloses that an encoding rate (RFCI) of a mobile station is controlled by a Radio Network Controller (RNC) (paragraphs 3-6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Siemens' reference with the teaching of Sato so that RNC-A' would have sent a command to change the encoding rate of a mobile station for accomplishing a TrFO, because such a modification would have clarified how RNC-A' successfully obtained a requested RFCI from a mobile station to achieve a TrFO.

1.8 Regarding claim 27, Siemens teaches a MSC in figure 6.

1.9 Regarding claim 28, Siemens teaches a MGW in figure 6.

1.10 Regarding claim 29, the modified Siemens reference teaches AMR (see para. 2 and 3 of Sato).

1.11 Regarding claim 30, Siemens teaches RFCI as stated above.

1.12 Regarding claim 31, Siemens teaches a transcoder free operation (TrFO) at the end of figure 6.

1.13 Regarding claim 32, Siemens discloses a system for achieving transcoder free operation in figures 5 and 6, comprising a first switching node MGM, a second switching node RNC-A', a first RNC-A and a second RNC-B that are belong to the first switching node (as defined by the applicant, both a MSC (or a MGW) and a RNC are as switching nodes throughout the specification). Siemens teaches inserting a transcoder (TrFO Break Function) in a network node (MGW) when a mobile station moves from RNC-A (first area covered by first RNC) to RNC-A' (second area covered by a second RNC), receiving RFCI map from RNC-A (step 4, figure 6) and sending the RFCI map to RNC-A' (step 11, figure 6). The RNC-A' changes to the RFCI map as requested and new TrFO operation is achieved (step 14 and thereafter, figure 6). Siemens fails to specifically teach tow network switch nodes and how the RFC-A' obtains the RFCI of the mobile station to achieve the TrFO operation (transcoder removed).

However, Sato discloses that an encoding rate (RFCI) of a mobile station is controlled by a Radio Network Controller (RNC) (paragraphs 3-6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Siemens' reference with the teaching of Sato

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so that RNC-A' would have sent a command to change the encoding rate of a mobile station for accomplishing a TrFO, because such a modification would have clarified how RNC-A' successfully obtained a requested RFCI from a mobile station to achieve a TrFO.

1.14 Regarding claim 33, Siemens teaches a MSC in figure 6.

1.15 Regarding claim 34, Siemens teaches a MGW in figure 6.

1.16 Regarding claim 35, the modified Siemens reference teaches AMR (see para. 2 and 3 of Sato).

1.17 Regarding claim 36, Siemens teaches RFCI as stated above.

1.18 Regarding claim 37, Siemens teaches a transcoder free operation (TrFO) at the end of figure 6.

2. Claims 20, 26, 32, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over LEV et al. US 5,608,779 in view of Sato et al. US2003/0032440.

Lev discloses a method and system in figures 1 and 2. Lev teaches that when a mobile station 116 requests of making a call (note: it is inherent that the mobile station

116 can be roaming into communication system 216 from another network controller of another switching network), a transcoder is inserted, and when switching center 201 determines that the requested call is mobile-to-mobile, the transcoder is removed to establish a transcoder free operation (TrFO) (column 2, line 47 to column 3, line 22; column 6, lines 12 to column 7, line 4). Lev fails to teach how to change the compression coding information for achieving TrFO.

However, Sato discloses that an encoding rate (RFCI) of a mobile station is controlled by a Radio Network Controller (RNC) (paragraphs 3-6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lev's reference with the teaching of Sato so that a controller would have sent a command to change the encoding rate of both mobile stations for achieving a TrFO (i.e. same encoding rate), because such a modification would have clarified how to achieve mobile-to-mobile TrFO.

Response to Arguments

3. Applicant's declaration under rule 37 CFR 1.131 has been received and considered, but is ineffective to establish a conception date of 28 August 2000 since there is no proof that Mr. Tamura shown in Exhibit 2 is the inventor of Exhibit 1 (e.g. a physics professor who teaches the law of gravity may not be the one who discovered the law of gravity).

4. Applicant's arguments with respect to claims 20-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is 571-272-7545. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at 571-272-7547. The fax phone number for

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the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.



S. Sing

03/07/2006



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600